<u>Remarks/Arguments</u>

Claims 1 to 17 remain in the application. Claim 11 has been amended.

Specification

The abstract has been objected to. The abstract has been amended in accordance with the Examiner's suggestions.

Claim Objections

Claim 11 is objected to because of informality. Claim 11 is herein amended to correct the informality in accordance with the Examiner's suggestions.

Objections under 35 USC § 102

Claims 1-17 have been rejected as being anticipated by Friskel (US 6,839,737), hereinafter referred to as the '737 reference. It is clear from a careful review of the '737 reference that "recognizing data stored in an electronic contact information database of a user system as data relating to a contact information of a new contact" is never performed. In particular at column 8, lines 45-52, the '737 reference discusses how some individuals are not in the contact database while others are. It further notes in the following paragraph that only those in the database are subject to the disclosed information request and that contacts can be added to those lists. That said, the '737 reference is silent as to actually recognizing new contacts as such. In effect one could add ten new contacts in a standard interval between contact status request, until the request is made no status information is available and the system has not recognized the new contacts.

In contrast, applicant has discovered that by recognizing that a contact within a contact database is a new contact it allows, in accordance with claim 1, the automatic population of contact information relating to the new contact.

It is a clear principle in United States patent law that the inclusion of a necessary step within a claim that is not disclosed or taught in the cited reference renders that claim novel

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over the cited prior art reference. Here, Friskel does not teach the above-mentioned step and as such cannot render the claim anticipated.

Claim 2 depends from claim 1 and as such cannot be anticipated.

Claim 3 depends from claim 1 and as such cannot be anticipated.

Referring to claim 4, it is asserted that at column 7, lines 16-30, there is disclosure of automatically extracting the additional contact information from the received return electronic message. In Friskel the status information is updated based on received emails specifically at lines 31-33, as highlighted in the official action, the email address of the sender of each newly received email is obtained. The email address is then compared to email addresses within a hidden contacts file. For emails received and their contact information being in the hidden contact file these would not relate to newly received contacts and therefore, clearly, claim 4 does not fall within the scope of Friskel and cannot be anticipated thereby. Further, claim 4 depends from claim 1 and, as such, is not anticipated.

Claim 5 depends from claim 4, which depends from claim 1, which is not anticipated.

Referring to claim 6, there is not disclosure within the '737 reference of verifying the authenticity of each electronic message received at a system of the new contact. In effect, the '737 reference discusses verifying a status of a series of contacts within a contact list by contacting a server in order to determine status. The '737 reference does not discuss verifying at a system of the new contact. As such claim 6 cannot be anticipated. Further claim 6 depends on claim 1 and therefore cannot be anticipated.

Referring to claim 7, the '737 reference does not disclose anything similar to claim 7. Claim 7 depends from claim 6 which is not anticipated. Further it depends from claim 1 which is not anticipated. Clearly in the '737 reference there is no teaching of verifying the authenticity of a message comprising a message body containing contact information for at least one contact information field for verification. As such claim 7 cannot properly be anticipated.

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Claim 8 depends from claim 6 and from claim 1 both of which are not anticipated and such claim 8 cannot be anticipated. Further, claim 8 recites that the return message is generated by an automated reply filter in execution on the contact system. The '737 reference refers to a status verification system in operation on a server, and thus does not teach an automated reply filter in operation on the contact system.

The '737 reference does not appear to disclose the limitation using the electronic message application in execution on a system of the new contact receiving the electronic message transmitted from the user system via communication network and then using an automated reply filter cooperatively in execution with the electronic message application intercepting the received electronic message prior to storing thereof within an inbox of the electronic message application. The '737 reference as noted above relates to status verification for email addresses stored within a contact database and relies on a central server to submit and receive there from status update information. As such claim 8 cannot properly be considered anticipated.

In claim 9 the limitations as set out in the entire claim relate to receiving an electronic message, using an automated reply filter parsing information fields, and generating the new electronic message including data indicative of current contact information. Further, claim 9 recites a step of parsing information fields to determine the electronic message is one of a contact information request message and another message. This step is not disclosed in the '737 reference - anywhere in that reference nor specifically in column 7, lines 31-35. As such claim 9 cannot be anticipated by the '737 reference.

It is noteworthy that claim 9 comprises a plurality of steps and it is essential in order to make a properly founded argument for anticipation that all of the steps are disclosed in a single embodiment. Clearly in the '737 reference the steps disclosed are not similar or analogous to the steps recited in claim 9 nor are they performed on the same system as disclosed in claim 9 nor are they for performing similar functions as those recited in claim 9. As such claim 9 cannot be anticipated.

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Claim 10 depends from claim 9, which is not anticipated and as such cannot be anticipated. Further there is no automated reply filter disclosed in the '737 reference and as such claim 10 is not properly anticipated thereby.

Claim 11 depends from claim 10, which depends from claim 9 and is therefore clearly not anticipated. Further claim 11 recites "absent a step of storing the received electronic message within the inbox" and referring to claim 9 all other messages are provided for storage within the inbox clearly in conjunction one with the other these recitations are outside the scope of the '737 reference and as such claim 11 is not anticipated.

Claim 12 depends from claim 9, which is not anticipated and as such claim 12 cannot be properly anticipated thereby.

Referring to claim 13, there is no teaching within the '737 reference of any identification of the electronic message or of an electronic message being transmitted. For example, in claim 13 it is recited " the electronic message being identified for interception by an automated reply filter in execution on the system of the new contact.", Firstly, the '737 reference does not have transmission of a message to the system of the new contact. Secondly, it does not disclose in any way identifying the electronic message for interception. As such claim 13 cannot be anticipated by the '737 reference.

Referring to claim 14 as amended herein clearly the '737 reference does not disclose the step of automatically sending a message requesting further contact information to the contact destination of the new contact. The '737 reference discloses contacting a server for status information relating to a contact within a contact database. That contact is an existing contact and those requests are sent out for the group of contact within the contact database. In contrast, claim 14 recites automatically sending a message requesting further contact information to the contact destination of the new contact. This is distinctive over the '737 reference and as such claim 14 is not anticipated thereby.

Referring to claim 15 once again a return message with further contact information from the new contact is recited in claim 15 this is not disclosed within the '737 reference and

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therefore claim 15 is not anticipated. Further, claim 15 depends from claim 14, which is not anticipated and as such is not anticipated.

Claim 16 depends from claim 15, which depends from claim14, which are both not anticipated and as such claim 16 is not anticipated. Further there is no disclosure within the '737 reference of automatically extracting the further contact information from the received return electronic message where the received electronic return electronic messages from the new contact. As such claim 16 is not anticipated.

Claim 17 depends from claim 16, which depends from claim 15, which depends from claim 14 all three of which are not anticipated and as such claim 17 cannot properly be considered anticipated.

The prior art made of reference and not relied upon been reviewed but has not been found to materially affect the scope of the claims.

A Petition for Extension of Time is filed concurrently with this response.

Please charge any additional fees required or credit any overpayment to Deposit Account No. 50-1142.

Applicant requests favourable reconsideration of the amended application.

Respectfully submitted,

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